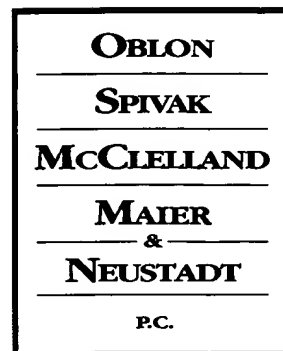




Docket No.: 197792US-28

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



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RE: Application Serial No.: 09/725,511
Applicants: Hiroaki ISHIZUKA
Filing Date: November 30, 2000
For: METHOD AND SYSTEM FOR ON-LINE
COMMUNICATION BASED ON AN OFF-LINE
TRANSACTION
Group Art Unit: 3624
Examiner: ALPERT, JAMES M.

SIR:

Attached hereto for filing are the following papers:

APPEAL BRIEF W/APPENDICES

Our credit card payment form in the amount of **\$500.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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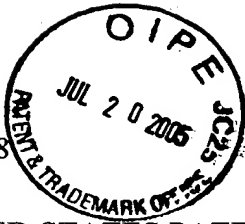
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
HIROAKI ISHIZUKA : EXAMINER: ALPERT, JAMES M.
SERIAL NO: 09/725,511 :
FILED: NOVEMBER 30, 2000 : GROUP ART UNIT: 3624
FOR: METHOD AND SYSTEM FOR ON- :
LINE COMMUNICATION BASED ON AN
OFF-LINE TRANSACTION

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants appeal the outstanding Final Rejection of February 3, 2005.

I. REAL PARTY-IN-INTEREST

The real party-in-interest in the present application is Ricoh Co. Ltd., the assignee of the present application, having a place of business at 3-6 Naka-Magome 1-chome, Ohta-Ku, Tokyo 143-8555, Japan.

II. RELATED APPEALS AND INTERFERENCES

Appellants, appellants' legal representative, and the assignee are not aware of any related pending appeals, interferences, or judicial proceedings that may be related to, or will be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-46 are pending in this application. Each of claims 1-46 stands rejected and the rejections of each of claims 1-46 are being appealed.

IV. STATUS OF AMENDMENTS

No Amendment was filed subsequent to the Final Rejection of February 3, 2005. A Response requesting reconsideration of the rejections was filed on March 11, 2005, but that Response did not present any amendments to the claims.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to the use of information obtained from an off-line transaction for use of an analysis of characteristics of a purchaser when considering whether or not to grant authorization for a subsequent on-line transaction. (Specification at page 1, lines 8-11).

The present inventor recognized that in electronic billing systems a person must often enter their billing and personal information at least once, and that it may be preferable if the user did not have to go through the tedious task of himself or herself entering all of their billing information. (Specification at page 1, lines 18-28.)

The present invention overcomes such deficiencies of known billing systems as, in the present invention, at least some information of or about the user obtained from an off-line transaction is utilized for an on-line transaction. (Specification at page 2, lines 2-5.)

According to a method and system for communicating according to the present invention, a customer's financial information is stored in a supplier computer system based on an off-line transaction between a customer and the supplier. (See for example the present specification at Figure 5, step S402, the present specification at page 10, line 22 to page 11,

line 5, the supplier computer system 200 and the databases 224, 226, 228.) An on-line purchase by a customer is begun with the supplier, and information of that beginning is communicated to a server computer by the customer. (See step 450 and Figures 6A-6D in the present specification, server computer 204, and the present specification at page 12, line 15 et seq.)

The method and system can then determine that the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system 200, and which is based on the off-line transaction. (See for example step S404 in Figure 4 in the present specification, and the present specification at page 11, line 6 et seq., and the supplier computer system 200.)

Further, information can then be communicated to the customer that the on-line purchase has been approved, after the determining determines that the customer is an acceptable risk. (See for example the present specification at page 14, line 13 et seq., Figure 9, and the display screen 650 which operates as part of a communication.)

As more specific features in the present invention, the customer's financial information can be based on a lease, which can be a lease of an image forming device, copier, and facsimile. (See for example Figure 4 in the present specification, and the present specification at page 8, line 2 to page 9, line 21.)

VI. ISSUES TO BE REVIEWED ON APPEAL

The first issue to be reviewed on appeal is whether claims 1, 9-24, and 32-46 are rendered obvious by the combination of teachings in U.S. patent 5,732,400 to Mandler et al. (herein "Mandler") in view of U.S. patent 6,282,522 to Davis et al. herein ("Davis '522"), under 35 U.S.C. § 103(a).

The second issue for review on appeal is whether the combination of teachings of Mandler in view of U.S. patent application publication 2001/0039516 to Bennett et al. (herein “Bennett”) and further in view of U.S. patent application publication 2002/0065754 to Lussi renders obvious claims 2-8 and 25-31, under 35 U.S.C. § 103(a).

VII. ARGUMENTS

CLAIMS 1-46

Each of the outstanding rejections relies on Mandler as the primary reference, and is based on the positions that the only deficiencies in Mandler are that (1) “[t]he Mandler patent lacks the information is based on an off-line transaction (claims 1 and 24)”, for which the teachings in Davis ‘522 are relied upon, for which the teachings in Davis ‘822 are cited¹, and (2) Mandler not “specifically disclos[ing] a lease for an image forming device such as a copier and a facsimile machine”, for which the Office Action takes Official Notice and cites Bennett to disclose that leases are viable financing (credit) information.²

In response to the rejections applicants respectfully submit no combination of teachings of Mandler in view of any of the secondary prior art references meets all the claimed limitations, and that further the suggested modifications needed to the teachings in Mandler to meet the claimed limitations would not have been suggested to one of ordinary skill in the art as such modifications are directly contrary to the entire objective of the device of Mandler and would destroy the objective of the device of Mandler.

Mandler does not disclose or suggest generating a database within a supplier computer system that stores financial information based on an off-line transaction between a customer and a supplier that has the supplier computer system. That is, in the claims as

¹ Final Rejection of February 3, 2005, page 4, middle paragraphs.

² Final Rejection of February 3, 2005, page 5, lines 2-9.

currently written a specific supplier that has had an off-line transaction with a customer stores financial information of the customer in the supplier's own computer system based on that off-line transaction. The supplier can then again access that financial information at a later time to determine whether to approve a subsequent on-line purchase.

In contrast to the claims as currently written, Mandler discloses merely being able to access an on-line financial clearinghouse. Mandler makes it clear that the system and method disclosed therein "provides for enabling on-line transactional services among sellers and buyers *having no previous relationship with each other*" (emphasis added, see the Abstract of Mandler).

In the claimed invention the goal is to allow a previous off-line transaction between a customer and a supplier to provide information that will be useful in determining whether to approve a subsequent on-line purchase. Such a basic operation of the claimed invention is contrary to the teachings of Mandler.

The basis for the outstanding rejection states:

The Mandler patent lacks the information is based on an off-line transaction (claims 1 and 24).

The Davis patent teaches information gathered from an off-line transaction (D-col. 9, lines 1-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Mandler patent with the teachings of the Davis patent so as to provide a system that is more encompassing and capable of using various types of information therein.³

Applicants respectfully submit the teachings in Davis '522 do not overcome the deficiencies in Mandler, and that it would not have been obvious to one of ordinary skill in the art to combine the teachings in Davis '522 to the teachings in Mandler.

³ Final Office Action of February 3, 2005, middle of page 4.

First, applicants note Davis '522 is directed to an architecture and system that uses a smart card for payment of goods and/or services purchased on-line over the internet.⁴ At column 9, lines 1-14 Davis notes the use of a processor card for off-line validation and for performing off-line processing and authentication. However, such teachings in Davis are completely irrelevant to the claimed features and are actually contrary to the teachings in Mandler, and thus could not be combined with the teachings in Mandler.

The claims are not directed to a device that utilizes a smart card for payment or authorization for an on-line transaction as in Davis '522. In Davis '522 the use of the smart card is for a concurrently executed on-line transaction. That is, in Davis '522 if a purchaser wishes to purchase something on-line the purchaser can utilize a smart card for an off-line authentication. Thus, in Davis '522 the transaction for which the off-line smart card is utilized is a concurrent transaction executed on-line. As a result, in Davis '522 all relevant information is stored in the smart card and is not stored in the supplier's computer system.

More particularly, in contrast to Davis '522, in the claims a customer's financial information is stored *in a supplier computer system* based on an off-line transaction between a customer and a supplier. That operation is not possible by any combination of teachings in Mandler in view of Davis '522. Mandler does not disclose such an operation and Davis '522 discloses a directly contrary operation. Davis '522 specifically discloses utilizing the smart card for storing information, which in Davis '522 would avoid the need to store a customer's financial information *in the supplier computer system*.

Further, in the claims the stored customer financial information is based on an *off-line transaction between a customer and a supplier*. The off-line processing utilized in Davis '522 at column 9, lines 1-14 has no relevance whatsoever to storing financial information

⁴ Davis '522 at the Abstract.

from such an off-line transaction in the supplier computer system. Thus, Davis '522 is further deficient in that respect.

Moreover, the teachings in a primary reference to Mandler could not possibly be modified in view of the teachings of Davis '522 as that would destroy the entire objective of the device of Mandler.

Mandler is specifically directed to a device that "provides for enabling on-line transactional services among sellers and buyers having *no previous relationship with each other*" (emphasis added, see the Abstract of Mandler). The claims require a directly contrary operation in that the claims require an off-line transaction between a customer and a supplier to result in storing customer financial information in a supplier computer system. The entire objective of the device of Mandler is directly contrary to the claimed features and in no possible way could Mandler be modified to meet the claim features. A modification to Mandler to operate in which a customer and a supplier have had a previous off-line transaction is directly contrary to the objective of Mandler to provide services when the seller and buyers have had no previous relationships with each. Thus, in no possible way could Mandler even be modified to meet the claim limitations.

In view of these foregoing comments, applicants respectfully submit that clearly claims 1-46 patentably distinguish over Mandler in view of Davis '522.

CLAIMS 2-8 and 25-31

Applicants respectfully submit claims 2-8 and 25-31 recite further features neither taught nor suggested by the applied art. More particularly, those claims are more specifically directed to utilizing a lease as the customer's financial information, and to further reciting that the lease may be for an image forming device, copier, and facsimile device.

First, the above-noted basis for the outstanding rejection is not at all understood as it does not even cite the teachings in Davis '522. Claims 2-8 and 25-31 depend from respective independent claims 1 and 24, and the Office Action recognizes that Mandler fails to teach or suggest features recited in independent claims 1 and 24. Thus, the entire basis for the rejection of claims 2-8 and 25-31 is unclear.⁵

Moreover, the above-noted claims are believed to be even further distinguished over the applied.

The outstanding rejections cites further teachings in Bennett and Lussi, but applicants respectfully submit the further reliance on the teachings in Bennett and Lussi is improper. More particularly, applicants note the above indicated dependent claims even further distinguish over the applied art.

For example, several of the dependent claims recite that the customer financial information is "based on a lease", and further can be "based on a lease of an image forming device", "copier" and "facsimile machine". With respect to such features, the outstanding Office Action asserts Bennett and Lussi "to illustrate that such concepts are well known".

In maintaining the outstanding rejection the Final Office Action states:

[a]lthough Mandler doesn't specifically disclose a lease for an image forming device such as a copier and a facsimile machine, the Examiner reaffirms her taking of Official Notice that such goods would fall within the purview of the type of goods covered in standard credit reports which are used as a basis for the credit analyses in Mandler, especially for businesses.⁶

The Final Office Action goes on to then cite the teachings in Bennett and Lussi. However, the cited teachings in Bennett and Lussi are not even relevant to the claimed features.

⁵ It appears the further rejection should have also cited Davis '522, and to promote prosecution in the following discussion that will be assumed.

⁶ Final Office Action of February 3, 2005, page 5, lines 4-8.

First, the outstanding rejection cites Bennett in paragraph [0016] to disclose utilizing leases. However, applicants note that what Bennett discloses is a computer enabling an individual to enter personal information about a buyer to obtain financing parameters for financing vehicles such as a lease. In that way, what Bennett discloses is being able to determine whether to grant a lease to an individual.

In contrast to the teachings in Bennett, in several of the dependent claims the lease is utilized as part of an off-line transaction that will determine whether to authorize a subsequent on-line transaction. Bennett clearly does not teach or suggest utilizing a lease in such a manner. In fact, Bennett discloses just the opposite as Bennett discloses utilizing information to determine whether to allow a lease.

The teachings in Lussi are also not deemed to be even remotely relevant to any of the claimed subject matter as Lussi also is completely silent as to utilizing information from an off-line transaction such as a lease with respect to whether to authorize a subsequent on-line transaction.

Thus, dependent claims 2-8 and 25-31 recite further features neither taught nor suggested by Mandler in view of Bennett and Lussi.

VIII. CONCLUSION

In view of these foregoing comments, applicants respectfully submit each of claims 1-46 is allowable over the current rejections, and that thus the current rejections must be REVERSED.

Respectfully submitted,

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CLAIMS APPENDIX

Claim 1 (Previously Presented): A method of communicating, comprising the steps of:

storing a customer's financial information in a supplier computer system based on an off-line transaction between a customer and a supplier;

beginning an on-line purchase by the customer with the supplier and communicating to a server computer by the customer;

determining that the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system and which is based on the off-line transaction;

communicating to the customer that the on-line purchase has been approved, after said determining step determines that the customer is an acceptable credit risk.

Claim 2 (Original): A method according to claim 1, wherein said step of storing comprises:

storing the customer's financial information based on a lease.

Claim 3 (Previously Presented): A method according to claim 1, wherein said step of storing comprises:

storing the customer's financial information based on a lease of an image forming device.

Claim 4 (Original): A method according to claim 1, wherein said step of storing comprises:

storing the customer's financial information based on a purchase of an image forming device.

Claim 5 (Original): A method according to claim 4, wherein said step of storing comprises:

storing the customer's financial information based on a purchase of at least one of a copier and a facsimile machine.

Claim 6 (Original): A method according to claim 1, wherein said determining step comprises:

determining that the customer is an acceptable credit risk based the existence of a lease of a machine by the customer.

Claim 7 (Previously Presented): A method according to claim 1, wherein said determining step comprises:

determining that the customer is an acceptable credit risk based the existence of a lease of a machine by the customer and up-to-date payments on the lease.

Claim 8 (Original): A method according claim 1, wherein said step of communicating to the customer comprises:

communicating that the on-line purchase which is a purchase of supplies for an image forming device which has been obtained through the off-line transaction has been approved.

Claim 9 (Original): A method according to claim 1, further comprising the step of:
issuing a bill for the on-line purchase.

Claim 10 (Original): A method according to claim 9, wherein said step of issuing a bill comprises:

issuing an electronic bill for the on-line purchase.

Claim 11 (Original): A method according to claim 10, wherein said step of issuing a bill comprises:

transmitting the electronic bill for the on-line purchase by email.

Claim 12 (Original): A method according to claim 10, wherein step of issuing a bill comprises:

notifying said customer that said electronic bill is stored at an Internet site.

Claim 13 (Original): A method according to claim 12, wherein said notifying step comprises:

notifying said customer by an electronic mail message that said electronic bill is stored at the Internet site.

Claim 14 (Original): A method according to claim 10, wherein said step of issuing a bill comprises:

issuing a single electronic bill for both the on-line purchase and a lease corresponding to the off-line transaction.

Claim 15 (Original): A method according to claim 9, further comprising the step of:

printing a paper bill for the on-line purchase, and sending the paper bill to the customer.

Claim 16 (Original): A method according to claim 9, further comprising the step of: debiting a pre-registered bank account by an amount corresponding to the on-line transaction.

Claim 17 (Original): A method according to claim 16, wherein said debiting step comprises:

debiting a pre-registered bank account by an amount corresponding to the on-line transaction and a payment for the off-line transaction.

Claim 18 (Original): A method according to claim 1, further comprising the step of: charging a third party credit card of the customer for the on-line transaction.

Claim 19 (Original): A method according to claim 1, further comprising the step of: issuing a paper bill for said transaction if said financial information is not valid.

Claim 20 (Original): A method according to claim 9, wherein said step of issuing comprises:

issuing the bill for the on-line purchase according to a predetermined billing cycle which is greater than one day.

Claim 21 (Original): A method according to claim 9, wherein said step of issuing comprises:

issuing a single bill for plural transactions occurring over a time period.

Claim 22 (Original): A method according to claim 1, further comprising the step of:
purchasing a product through the on-line purchase, the product being different from a product obtained through the off-line transaction.

Claim 23 (Original): A method according to claim 22, wherein said step of
purchasing comprises:

purchasing the product through the on-line purchase which is for use with the product obtained through the off-line transaction.

Claim 24 (Previously Presented): A system for communicating, comprising:
means for storing a customer's financial information in a supplier computer system based on an off-line transaction between a customer and a supplier;

means for beginning an on-line purchase by the customer with the supplier and communicating to a server computer by the customer;

means for determining that the customer is an acceptable credit risk for the on-line purchase using the customer's financial information in the supplier computer system and which is based on the off-line transaction; and

means for communicating to the customer that the on-line purchase has been approved, after means for determining determines that the customer is an acceptable credit risk.

Claim 25 (Original): A system according to claim 24, wherein said means for storing comprises:

means for storing the customer's financial information based on a lease.

Claim 26 (Previously Presented): A system according to claim 24, wherein said means for storing comprises:

means for storing the customer's financial information based on a lease of an image forming device.

Claim 27 (Original): A system according to claim 24, wherein said means for storing comprises:

means for storing the customer's financial information based on a purchase of an image forming device.

Claim 28 (Original): A system according to claim 27, wherein said means for storing comprises:

means for storing the customer's financial information based on a purchase of at least one of a copier and a facsimile machine.

Claim 29 (Original): A system according to claim 24, wherein said means for determining comprises:

means for determining that the customer is an acceptable credit risk based the existence of a lease of a machine by the customer.

Claim 30 (Previously Presented): A system according to claim 24, wherein said means for determining comprises:

means for determining that the customer is an acceptable credit risk based the existence of a lease of a machine by the customer and up-to-date payments on the lease.

Claim 31 (Original): A system according claim 24, wherein said means for communicating to the customer comprises:

means for communicating that the on-line purchase which is a purchase of supplies for an image forming device which has been obtained through the off-line transaction has been approved.

Claim 32 (Original): A system according to claim 24, further comprising:
means for issuing a bill for the on-line purchase.

Claim 33 (Original): A system according to claim 32, wherein said means for issuing a bill comprises:

means for issuing an electronic bill for the on-line purchase.

Claim 34 (Original): A system according to claim 33, wherein said means for issuing a bill comprises:

means for transmitting the electronic bill for the on-line purchase by email.

Claim 35 (Original): A system according to claim 33, wherein means for issuing a bill comprises:

means for notifying said customer that said electronic bill is stored at an Internet site.

Claim 36 (Original): A system according to claim 35, wherein said means for notifying comprises:

means for notifying said customer by an electronic mail message that said electronic bill is stored at the Internet site.

Claim 37 (Original): A system according to claim 33, wherein said means for issuing a bill comprises:

means for issuing a single electronic bill for both the on-line purchase and a lease corresponding to the off-line transaction.

Claim 38 (Original): A system according to claim 32, further comprising:

means for printing a paper bill for the on-line purchase.

Claim 39 (Original): A system according to claim 32, further comprising:

means for debiting a pre-registered bank account by an amount corresponding to the on-line transaction.

Claim 40 (Original): A system according to claim 39, wherein said means for debiting comprises:

means for debiting a pre-registered bank account by an amount corresponding to the on-line transaction and a payment for the off-line transaction.

Claim 41 (Original): A system according to claim 24, further comprising:

means for charging a third party credit card of the customer for the on-line transaction.

Claim 42 (Original): A system according to claim 24, further comprising:
means for issuing a paper bill for said transaction if said financial information is not valid.

Claim 43 (Original): A system according to claim 32, wherein said means for issuing comprises:

means for issuing the bill for the on-line purchase according to a predetermined billing cycle which is greater than one day.

Claim 44 (Original): A system according to claim 32, wherein said means for issuing comprises:

means for issuing a single bill for plural transactions occurring over a time period.

Claim 45 (Original): A system according to claim 24, further comprising:
means for purchasing a product through the on-line purchase, the product being different from a product obtained through the off-line transaction.

Claim 46 (Original): A system according to claim 45, wherein said means for purchasing comprises:

means for purchasing the product through the on-line purchase which is for use with the product obtained through the off-line transaction.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.